

Claims 1-55 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23, 31, 54-82, 84-87, 90-107 of copending Application No. 09/350,579.

Claims 1-21 and 25-55 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 and 17-42 of copending Application No. 09/287,176.

Although Applicant disagrees with the rejection, she nevertheless files together with this amendment a terminal disclaimer, disclaiming any portion of any patent issuing from the present application that would extend past the term of any patent issuing from the three cited applications. Accordingly, Applicants request withdrawal of the double-patenting rejections.

### **III. Rejection under 35 U.S.C. § 102(e)**

The rejection of Claims 1-6, 10-17, 25-29, 32-34, and 38-47 under 35 U.S.C. § 102(e) as being anticipated by *Rondeau et al.* (U.S. Pat. No. 6,001,135) has been maintained for reasons of record. (Office Action, pages 2-3.) The Office states that Applicant's remarks regarding claims 7-9 are persuasive, and those claims are not included in the instant rejection. (*Id.*, page 2.)

Applicant respectfully traverses this rejection for the reasons of record. In order to advance the prosecution of the application, however, Applicant has amended each of the independent claims to recite the limitations of claim 7. Accordingly, the rejection has been obviated and Applicant respectfully requests entry of the amendment, reconsideration and withdrawal of the rejection, and allowance of all pending claims.

**IV. Rejection under 35 U.S.C. § 103(a)**

**Rondeau et al.**

Claims 1-55 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rondeau et al.* for the reasons set forth on pages 3-5 of the present Office Action, and for the reasons of record. Applicant traverses this rejection for reasons of record, and as supplemented below.

As discussed above, Applicant has amended the independent claims so that they now recite only the specific thickening polymers previously recited in claim 7.

Accordingly, the present claims are further distinguishable from *Rondeau*.

To establish a *prima facie* case of obviousness, the Office must meet three basic criteria. First, the Office must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. Second, the Office must demonstrate that there was a reasonable expectation of success. Finally, the prior art reference(s) must also teach or suggest all the claim limitations. See M.P.E.P. § 2143.

In the present case, the Office has failed to make a *prima facie* case of obviousness because at least the first two of the above criteria have not been met.

In particular, with respect to the thickening polymers of the present claims, Applicant has argued that there would be no motivation to substitute “organic pulverulent excipients” from the list in column 23 of *Rondeau* for the sawdust in example 2. The Office asserts that “[t]here is no motivation needed to substitute equivalents as long as the prior art recognizes the equivalence. Such equivalence is taught at column 23 lines

24-31" of *Rondeau et al.* (Final Office Action, page 4.) Applicant maintains her position that "organic pulverulent excipients" are not art recognized equivalents of Applicant's specifically recited "thickening polymers".

As argued of record, in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on Applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. See *In re Ruff*, 356 F.2d 590, 118 U.S.P.Q. 340 (CCPA 1958) *Rondeau et al.*'s organic pulverulent excipient is just that, *i.e.*, "an inert substance used as a diluent or vehicle" (excipient<sup>1</sup>) "made of, covered with, or crumbling to fine powder or dust" (pulverulent<sup>2</sup>). The present invention concerns novel compositions for dyeing keratin fibers which are capable of giving more intense and yet unselective colorations which show good resistance to the various attacking factors to which the hair may be subjected, by combining at least one of the recited thickening polymers with at least one known cationic direct dye. (Specification, page 2, line 19, through page 3, line 5.) *Rondeau et al.* does not disclose using the recited thickening polymers for giving more intense and yet unselective colorations which show good resistance to the various attacking factors to which the hair may be subjected. Accordingly, there is no reason why one of ordinary skill in the art would conclude that the excipients taught by *Rondeau et al.* at column 23, lines 24-31, are equivalent to the thickening polymers taught and claimed in the present application. Therefore, because

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<sup>1</sup> *The American Heritage College Dictionary (Third Edition)*, Houghton Mifflin Company, Boston, 2000.

no motivation exists to make the substitution suggested by the Office, the Applicant respectfully requests that the Office reconsider and withdraw the rejection.

Further, the Office has not responded to the Applicant's argument, filed February 13, 2001, that even if one did make the substitution suggested by the Office, there would have been no reasonable expectation of success. To establish a *prima facie* case of obviousness, the Office must demonstrate that there was a reasonable expectation of success. See M.P.E.P. § 2143. The Office, in the present case, has not met this burden. For this additional reason, the rejection should be withdrawn.

**V. Conclusion**

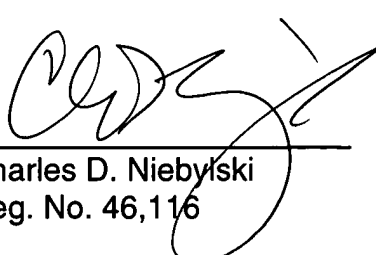
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our deposit account, Deposit Account No. 06-0916.

Respectfully submitted,

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By:

  
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